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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,678	03/03/2004	Matthew Rubin Lerner	003797.00912	2303

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EXAMINER

VAUGHN, GREGORY J

ART UNIT PAPER NUMBER

2178

DATE MAILED: 06/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/790,678	LERNER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gregory J. Vaughn	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3/3/04, 3/18/04</u>   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Action Background*

1. This action is responsive to the application filing, application filed on 3/3/2004.
2. Claims 1-4 are pending in the case, claim 1 is the independent claim.
3. Acknowledgement is made to the applicant's submission of two Information Disclosure Statements, filed 3/3/2004 and 3/18/2004.

### *Priority*

4. Applicant's claim for priority as a divisional application to US Patent application 09/521,022, filed 3/7/2000, now US Patent 6,859,909 is acknowledged.

### *Specification*

5. The disclosure is objected to because of the following informalities:
  - The disclosure recites "*a category 320 field*" (page 8, paragraph 42) in reference to Figure 4. The category field shown in Figure 4 is shown with reference sign 420.
  - The disclosure recites "*a temporary stroke record 6900*" (page 24, paragraph 84). A stroke record is shown in Figure 6 as reference sign 600.

Appropriate correction is required.

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6. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

*"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."*

8. Claims 1-4 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. **Regarding claims 1-4**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract

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idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward organizing collections of annotated web-based documents, by receiving annotated documents, generating a thumbnail image, associating searchable attributes and obtaining a subset of annotated documents by searching. Applicant's claims describe the steps taken to manipulate (receive, generate, associate, search and obtaining) the nonfunctional descriptive material (i.e. the annotated web-based documents), but fail to produce a tangible result. A tangible result would include producing some result for a user of the system. An example of a tangible result is disclosed by applicant in the originally filed disclosure on page 23, paragraph 81 (displaying the thumbnail to a user) or the display of the search interface shown in Figure 16.

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*"A person shall be entitled to a patent unless –*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States."*

11. Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Golovchinsky et al. US Patent 6,389,435, filed 2/5/1999, patented 5/14/2002 (hereinafter Golovchinsky).

12. **Regarding independent claim 1**, Golovchinsky discloses a plurality of annotated documents, where the annotated documents are web-based documents with annotation data. Golovchinsky discloses web-based documents as hypertext documents (see column 1, lines 15-40) used on the Internet (column 3, lines 31-39). Golovchinsky discloses annotation data as digital ink in Figures 2 and 3 (shown at reference signs 42, 44 and 46). Golovchinsky discloses generating a thumbnail of the annotated document in figure 4. Golovchinsky discloses associating searchable attributes to the annotation data with a searchable index. Golovchinsky recites: *"this invention facilitates navigation from an index to portions of a document that are of interest to a user using freeform digital ink. A user can mark terms in an index page using freeform digital ink and the freeform digital ink mark is copied to*

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*instances of the annotated terms that occur in the document"* (column 1, line 67 to column 2, line 5). Golovchinsky discloses searching the plurality of annotated documents for a subset of the annotated documents. Golovchinsky recites: "*An embodiment of the system and method of this invention treats the selection of multiple original freeform digital ink marks as a query that causes the system to display a ranked list of search results*" (column 4, lines 27-31).

13. **Regarding dependent claim 2**, Golovchinsky discloses an annotation element in Figures 2 and 3 at reference signs 42, 44 and 46.
14. **Regarding dependent claim 3**, Golovchinsky discloses an annotation element in the form of ink marks in Figures 2 and 3 at reference signs 42, 44 and 46.
15. **Regarding dependent claim 4**, Golovchinsky discloses ink mark shapes in Figures 2 and 3 at reference signs 42, 44 and 46.


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***Conclusion***

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Gregory J. Vaughn  
Patent Examiner  
June 9, 2006